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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,617	01/04/2002	Nina Mishra	10007456 -1	2513
7	590 09/09/2004		EXAM	INER
HEWLETT-PACKARD COMPANY			AL HASHEMI, SANA A	
Intellectual Property Administration				
P. O. Box 272400			ART UNIT	PAPER NUMBER
Fort Collins, CO 80527-2400			2171	

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  Estansions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed safer SIX (6) MONTHS from the mailing date of this communication.  If the period for reply is specified above is best than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.  If NO period for reply is specified above is best than thirty (30) days, a reply within the safety of SIX (6) MONTHS from the mailing date of the scommunication.  Failure to reply within the set or extended period for reply will, by statute, cause the application to become RABNONED (35 U.S. C. § 113).  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).  Status  1) Responsive to communication(s) filed on Q4 January 2002.  2a) This action is FINAL.  2b) This action is non-final.  3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.  Disposition of Claims  4) Claim(s) 1-10 is/are pending in the application.  4a) Of the above claim(s) is/are withdrawn from consideration.  5) Claim(s) is/are allowed.  6) Claim(s) is/are allowed.  6) Claim(s) is/are objected to.  8) Claim(s) are subject to restriction and/or election requirement.  Application Papers  9) The precification is objected to by the Examiner.  10) The drawing(s) filed on Q4 January 2002 is/are: a) accepted or b) objected to by the Examiner.  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).							
Examiner Sana Al-Hashemi 2171  - The MAILING DATE of this communication appears on the cover sheet with the correspondence address — Period for Reply  A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ② MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  - Enterpolate of them not be available under the production at 37 CMR 1.758(b), in an overal, however, may a right be threely filled  - If the period to ringly specified above, the anacture period will apply and will expire SIX (b) MXXNTIS from the realing plate of this communication.  - If the period to ringly specified above, the shortman statutory period will expire sold will be communicated threely.  - If the period to ringly specified above, the shortman statutory period will expire sold will be communicated threely (bit) days will be considered timely.  - If the period care will be official into the term ceriod will apply and will expire SIX (b) MXXNTIS from the realing late of this communication.  - If the period care will be official into the tree threely also day and any expire sold will expire SIX (b) MXXNTIS from the realing late of this communication.  - Any reply residue by the Official than these more is a first the milling date of the communication, even if timely filled, may reduce any communication.  - Any Expirement of the major than the short of the major short of the major short of the communication.  - Any Expirement of the major short of the major short of the communication.  - The MAILING DATE of this communication of the communication of the communication.  - The major short of the product of the communication of the communication.  - The major short of the short of the communication of the communication.  - The MAILING DATE of THIS COMMUNICATION.  - This action is short of the communication.  - The MAILING DATE of T		Application No.	Applicant(s)				
Sana Al-Hashemi	Office Action Summer	10/039,617	MISHRA ET AL.				
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2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) 5) Notice of Informal Patent Application (PTO-152)							
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Application/Control Number: 10/039,617

Art Unit: 2171

## **DETAILED ACTION**

Claim Status: 1-10 pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter.

Claim 1-10 are rejected under 35 U.S.C. 101 because none of the independent claims in conjunction with all dependent claims are statutory.

The claimed subject matter is directed to a "mathematical algorithm". As such, the claimed subject matter is not statutory and not eligible for patent protection.

No mathematical equation can be used, as a practical matter, without establishing and substituting values for the variable expressed therein. Substitution of values dictated by the formula has thus been viewed as a form of mathematical step. If the steps of gathering and substituting values were alone sufficient, every mathematical equation, formula, or algorithm having any practical used would be per se subject to patenting as a "process" under 101. Consideration of whether the substitution of specific values is enough to convert the disembodied ideas present in the formula into an embodiment of those ideas, or into an application of the formula, is foreclosed by the current state of law.

For subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technology arts. See Alappat, 33 F. 3d at 1543, 31 USPQ 2d at 1556-57 (quoting Diamond v. Diehr, 450 U.S. at 192, 209 USPQ at 10). See also Alappat 33 F. 3d at 1569, 31 USPQ2d at 1578-79

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(Newman, J., concurring)("unpatentability of the principle does not defeat patentability of its practical application") (citing O' Reilly v. Mores, 56 U.S. (15 how.) at 114-19). A claim is limited to a practical application when the method, as claimed, produces concrete, tangible and useful results; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. See AT&T, 172 F.3d at 1358, 50USPQ2d at 1452.

For a claimed invention to be statutory, the claimed invention must be within the technological art. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological art fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In Bowman (Ex parte Bowman, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished), the board affirmed the rejection under U.S.C. 101 as being directed to non-statutory subject matter. Although Bowman discloses transforming physical media into a chart and physically plotting a point on said chart, the Board held that the claimed invention is nothing more than an abstract idea, which is not tied to any technological art or environment.



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In the present case, claims 1, 6, and 9, recite an mathematical algorithm which can be implemented by the mind of a person or by the use of a pencil and paper. In another words, since the claimed invention, as a whole, is not within the technological arts as explained above, these claims only constitute an idea and does not apply, involve, use, or advance the technological arts, thus, it is deems to be directed to non-statutory subject matter.

## Points of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sana Al-Hashemi whose telephone number is (703) 305-4881. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436. Any response to this office action should be mailed to: The Commissioner of Patents and Trademarks, Washington, D.C. 20231. Or telefax at phone number (703) 746-7416. For formal or draft communications, please label "PROSPOSED" or "DRAFT". Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, 6<sup>th</sup> Floor Receptionist, Arlington, Virginia. 22202.

Sana Al-Hashemi Patent Examiner Technology Center 2100 August 26, 2004

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